II. REMARKS

This application has been reviewed carefully in view of the Office Action mailed June 25, 2002. In that Office Action, claims 1, 3, 4, 6-9, 13, 14 and 17-26 were rejected under 35 U.S.C. § 103(a), as allegedly unpatentable over Moss, U.S. Pat. No. 6,185,093, in view of Cranston, III et al., U.S. Pat. No. 5,708,563. Claim 5 was rejected under 35 U.S.C. § 103(a), as allegedly unpatentable over Moss in view of Cranston, III et al., and further in view of Welsh, U.S. Pat. No. 4,935,847. Claims 10, 12 and 15 were rejected under 35 U.S.C. § 103(a), as allegedly unpatentable over Moss in view of Cranston, III et al., and further in view of Clements, U.S. Pat. No. 5,963,681. Claim 11 was rejected under 35 U.S.C. § 103(a), as allegedly unpatentable over Moss in view of Cranston, III et al., and further in view of Beak, U.S. Pat. No. 5,496,185.

**A. THERE IS NO SUGGESTION TO COMBINE THE CITED REFERENCES**

The rejections of pending claims 1, 3-15 and 17-26, were for alleged obviousness under 37 U.S.C. § 103(a). Each such rejection included a recitation of the Moss patent in view of the Cranston, III et al. patent.

Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. *In regarding Fritch, 972 f.2d 1260, 1266 (Fed. Cir. 1992)*. The appropriate inquiry is *not* whether it would have been obvious to substitute an element, or modify the prior art, in a manner advanced by the Examiner, because that is not the appropriate test of patentability. *See, e.g., In regarding Fine, 837 F.2d 1071, 1075 (Fed. Cir. 1988)*. Rather, to meet its burden of showing prima facie obviousness, the PTO must necessarily show some objective teaching that would lead one of ordinary skill to combine the relevant teachings to solve the problem confronting the applicant. *See, In regarding Fine, supra.*

Therefore, to establish a *prima facie* case of obviousness, there must be some suggestion or motivation to modify the reference or combine the reference teachings. The teaching or suggestion to make the claimed combination must be found in the prior art and not based on an applicant's disclosure. *See, M.P.E.P. § 706.02(j).*

As seen in Figs. 3-5, Moss relates to an carrier assembly (100) used to mount PCI expansion cards (28) on a motherboard (30). To do so, the carrier assembly removably mounts in a computer system chassis (26) by inserting through a slot (102) on the chassis. The carrier assembly includes a carrier (46) made of plastic, and a jumper board (28) formed from a printed circuit board. The jumper board is screwed or riveted onto the carrier. The central problem addressed by Moss is providing a device that protects and aligns an expansion card during insertion and removal of the card from a live chassis. *See, col. 1, lines 4-6, and col. 1, lines 37-41*

Cranston III, et al. relates only to a card cage that contains both a planar circuit board that includes a CPU(i.e., a motherboard), and various accessory boards that plug into the motherboard. The motherboard is the heart of the computer system, containing devices essential to the operation of the computer. *See, col. 3, lines 24-30. See, col. 4, lines 31-35.*

There is no suggestion in either Cranston III, et al. or Moss to combine their disclosures. Indeed, actuating the Cranston III, et al. device removes the motherboard and accessory boards, and thus completely shuts down the computer. This is entirely contrary to the basic problem solved by Moss, i.e., to allow board removal from a live computer. Thus, those skilled in the art would not modify the device of Moss in light of the disclosure in Cranston III, et al.

Because the cited art fails to include a teaching or suggestion to make the claimed combination, the Patent Office has failed to establish a *prima facie* case of obviousness. Accordingly, the rejections of claims 1, 3-15 and 17-26, under

37 U.S.C. § 103(a) is improper, and Applicant respectfully requests they be withdrawn.

### B. THE CITED ART FAILS TO DISCLOSE THE FEATURES RECITED IN CLAIM 5

Claim 5 was rejected under 35 U.S.C. § 103(a), as allegedly unpatentable over Moss in view of Cranston, III et al., and further in view of Welsh, U.S. Pat. No. 4,935,847. The invention, as recited in claim 5, provides for a multi-functional handle that simplifies manufacturing of embodiments of the invention. In particular, the invention recited in claim 5 includes:

> a guide at the front end of the body, the guide being configured to guide movements of the card in mating the card system connector with the first system connector, and the guide being configured to support the card when the card system connector is mated with the first system connector; and a handle integral with the guide, the handle being configured for controlling the insertion and extraction of the carrier into and out of the chassis.

The Examiner asserts that it would have been obvious to a person having ordinary skill in the art to use a handle on the front end of the carrier, as taught by Welsh. However, there is no disclosure or suggestion in Welsh that the handle on the Welsh device could serve a function internal to the chassis, such as guiding a PCI card into a slot. Indeed, the handle of Welsh is entirely on the external end of the Welsh device, and could not serve such a function.

Because the cited art fails to disclose a carrier handle that integrally supports and guides a card with respect to a system connector, the rejection of claim 5 under 37 U.S.C. § 103(a) is improper, and Applicant respectfully requests it be withdrawn.

### C. ADDITIONAL CLAIMS

Applicant has added additional claims to better claim Applicant's invention.

## CONCLUSION

In view of the foregoing amendments and remarks, Applicant requests favorable consideration and allowance of all claims in the application.

Respectfully submitted,

The Law Office of John A. Griecci

By: _____
John A. Griecci
Reg. No. 39,694

2201 East Willow St., Ste. D, PMB 344
Signal Hill, California 90806-2142
(562) 985-1158